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10/540,337

11/07/2005

Jan Schroers

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CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1793

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application No. 10/540,337 | Applicant(s) SCHROERS ET AL. | |
| | Examiner George P. Wyszomierski | Art Unit 1793 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 48,50,54 and 60 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,14,18,20 and 24-27 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,8,12,15,17,28-32,34,36,39,40,42,44,46 and 47 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/22/06</u> . | 6) <input type="checkbox"/> Other: ____. |

Continuation of Disposition of Claims: Claims pending in the application are 1-3,5,6,8,12-15,17,18,20,24-32,34,36,39,40,42,44,46-48,50,54 and 60.

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1. *General Information*

a) The preliminary amendment filed June 20, 2005 has been entered. Claims 1-3, 5, 6, 8, 12-14, 17, 18, 20, 24-32, 34, 36, 39, 40, 42, 44, 46-48, 50, 54 and 60 are pending.

b) A copy of provisional application 60/435408, filed December 20, 2002, is of record. The provisional application fully discloses the subject matter of claims 25-32, and therefore the effective priority date of those claims is considered to be December 20, 2002.

2. *Restriction Requirement*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 5, 6, 8, 12-14, 17, 18, 20, 24-32, 34, 36, 39, 40, 42, 44, 46 and 47, drawn to alloy compositions, classified in class 148, subclass 403.
- II. Claims 48, 50, 54 and 60, drawn to a process, classified in class 164, subclass 122.

3. The inventions are independent or distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process

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(MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process, such as a vapor deposition process.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

5. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with John Peck, attorney of record, on March 17, 2008 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-3, 5, 6, 8, 12-14, 17, 18, 20, 24-32, 34, 36, 39, 40, 42, 44, 46 and 47. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 48, 50, 54 and 60 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. *Claim Interpretation*

a) Page 4, lines 13-14 of the specification states that the invention is directed to "Pt-based bulk-solidifying amorphous alloys, which are referred to as Pt-based alloys herein." Thus, the term "bulk-solidifying amorphous" will be implied in all the claims directed to Pt-based alloys.

b) In claims 1 and 13, it would appear that the last two lines of these claims should state that Pt comprises "at least" 75 or 85 percent, respectively, and the claims are being interpreted in this manner.

9. Claims 2, 15, 17 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claim 2, the lower range of "c" and the upper range of "e" are outside the bounds set forth in independent claim 1.

b) Claim 15 states that d is 0, in conflict with independent claim 13 which states that d is from 1 to 12.

c) Claim 17 recites three potential scenarios for the total content of Pd and Pt. However, the first two of these scenarios are not possible in independent claim 13.

d) Claim 30 states that the alloy is Ni free. This conflicts with claim 29, which states that "y" is a positive number.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 28, 29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 2002-275605. At least alloy no. 10 on page 5 of the JP '605 reference is fully in accord with the instant claims.

12. Claims 1, 3, 5, 8, 12, 36, 40, 42 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu et al. (U.S. Patent 6,749,698).

At least alloys 2, 3, 21 and 22 in the Tables of Shimizu appear to be fully in accord with the compositions as recited in the instant claims. With respect to claims 8 and 12, it is noted

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that the amount of the elements recited in these claims may be zero. The Vickers hardness of these alloys is greater than 400, and they are cast in a thickness greater than 5 mm. With respect to claim 42, the examiner's position is that the prior art alloys possess at least some resistance to embrittlement as defined in the instant claim. With respect to claim 47, see Shimizu column 5, line 7. Thus, all aspects of the claimed invention are held to be fully disclosed by Shimizu et al.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 34, 39, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al.

The Shimizu patent, discussed supra, does not discuss the values of the properties as recited in the instant claims. However, because the actual compositions of Shimizu are the same as those presently claimed, it is a reasonable assumption that the properties thereof would likewise be the same or nearly so; see *In re Best* (195 USPQ 430, CCPA 1977) or *In re Spada* (15 USPQ 2d 1655, Fed.Cir. 1990). Thus, a prima facie case of obviousness is established between the disclosure of Shimizu et al. and the presently claimed invention.

15. Claims 13, 14, 18, 20, and 24-27 are allowable over the prior art of record. Also, claims 2, 15, 17 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of

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the limitations of the base claim and any intervening claims. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not disclose or suggest alloy compositions as recited in these claims.

16. The remainder of the art cited on the attached PTO-892 and 1449 form is of interest. This art is held to be no more relevant to the claimed invention than the art as applied in the rejections, *supra*.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/George Wyszomierski/
Primary Examiner
Art Unit 1793

GPW
March 19, 2008